

REMARKS

Reconsideration of the rejections set forth in the Office action mailed September 30, 2004 is respectfully requested.

I. Amendments

Claims 1, 3-6, 10, 12-13, 17 and 19-20 have been amended to replace "comprises fluorine" with "includes a fluorine atom", and to replace "comprises fluorine or oxygen" with "include a fluorine atom or an oxygen atom", in the description of defined substituents on the claimed chemical structure.

The preamble of claim 10 has been amended to replace "effecting immunosuppression" with "inhibiting production of IL-2 in cells". Support is found, for example, at page 15, lines 16-20 of the specification.

No new matter is added by any of the amendments.

II. Rejections under 35 U.S.C. §112, First Paragraph

Claims 1-23 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As stated in MPEP §2173 ("Claims Must Particularly Point Out and Distinctly Claim the Invention"):

The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. §112, first paragraph with respect to the claimed invention.

The Examiner objected to the use of the term "comprises" in claims 1-9.

The pertinent claims have been amended, as noted above, to replace the phrase "comprises fluorine" with "includes a fluorine atom", and to replace the phrase "comprises fluorine or oxygen" with "include a fluorine atom or an oxygen atom", in the description of defined substituents on the claimed chemical structure.

Applicants submit that the metes and bounds of the claimed structure, and the defined substituents, would be clear to one skilled in the art. For example, the following portion of claim 1:

CR¹R² is selected from CHO_H, C=O, CHF, CF₂ and C(CF₃)OH;
CR⁶ and CR¹³ are selected from CH, COH and CF;
CR⁷R⁸, CR⁹R¹⁰ and CR¹¹R¹² are selected from CH₂, CHO_H, C=O, CHF and CF₂; and
CR³R⁴R⁵ is selected from CH₃, CH₂OH, C=O, COOH, CH₂F, CHF₂ and CF₃;

clearly define the possible embodiments of each of substituents R¹ through R¹³.

The subsequent line of the claim, namely:

at least one of R¹-R¹³ includes a fluorine atom; (or, as previously stated, "comprises fluorine")

further defines the structure, by requiring that at least one of these substituents must be selected from the possible embodiments such that it contains a fluorine atom. For example, since "CR¹R² is selected from CHO_H, C=O, CHF, CF₂ and C(CF₃)OH", selecting either R¹ or R² to be F or CF₃ would satisfy this requirement.

Because the possible embodiments of each substituent are clearly set out in the claim, they do not "embrace a set of various compounds or groups which are either known or unknown in the art".

III. Further Rejections under 35 U.S.C. §112, First Paragraph

The Examiner also objected to the terminology "effecting immunosuppression" in claim 10 and "inducing apoptosis in a cell" in claim 17.

The phrase "effecting immunosuppression" has been replaced with the more precise

"inhibiting production of IL-2 in cells", as noted above. However, it is unclear to the applicants what could be considered indefinite about the phrase "inducing apoptosis in a cell". The fact that these claim preambles do not "represent a method of treating a specific...disease" (Office Action, page 2) is not pertinent to the claim definiteness standards of 35 U.S.C. §112, second paragraph. The metes and bounds of the claims are not indefinite. It would be very clear to one skilled in the art that the claims would be infringed by administering the recited compound to a subject and/or contacting it with a cell, such that apoptosis was induced and/or production of IL-2 was inhibited.

With respect to utility (although no utility objection has been made), applicants refer again to the MPEP (§2107.01.III), which states that the "Courts have repeatedly found that the mere identification of a pharmacological activity of a compound that is relevant to an asserted pharmacological use provides an 'immediate benefit to the public' and thus satisfies the utility requirement".

In view of the foregoing, the applicants submit that the pending claims comply with the requirements of 35 U.S.C. §112, second paragraph.

IV. Conclusion

In view of the foregoing, the applicant submits that the claims now pending are now in condition for allowance. A Notice of Allowance is, therefore, respectfully requested.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 838-4403.

Respectfully submitted,


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